ESTTA Tracking number: **ESTTA279719**

Filing date: **04/22/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92048667
Party	Plaintiff Jules Jurgensen/Rhapsody, Inc.
Correspondence Address	STUART E. BECK THE BECK LAW FIRM 1500 WALNUT STREET, SUITE 700 PHILADELPHIA, PA 19102-3504 UNITED STATES BeckPatent@aol.com
Submission	Other Motions/Papers
Filer's Name	Stuart E. Beck
Filer's e-mail	BeckPatent@aol.com
Signature	/Stuart E. Beck/
Date	04/22/2009
Attachments	JJ's Resp to PB Motion to Strike Testimony of MC.pdf (9 pages)(47696 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Jules Jurgensen/Rhapsody, Inc.,

Petitioner,

Cancellation No. 92048667

v.

Peter Baumberger,

PETITIONER'S BRIEF IN RESPONSE TO RESPONDENTS
TO
MOTION TO STRIKE THE TESTIMONY OF MORTON CLAYMAN
(Corrected in the first line; the first word)

Respondent's motion to strike the testimony of Morton Clayman is not well taken and should be dismissed.

If Respondent believes that Petitioner failed to make its required pre-trial disclosures, Respondent should have moved the Board to delay or reset any subsequent pre-trial disclosure deadlines and/or testimony periods. Rule 12 1(e). Actually, respondent acknowledges the availability of this remedy on page 6 of its brief in the conclusion.

Mr. Clayman is the sole witness testifying on behalf of the Petitioner. His testimony is critical to Petitioner's case.

The standard for judging if testimony should be excluded is setout in *Spray-Rite Service Corp. v, Monsanto Co., 684 F.2d 1226 (7th Cir. 1982),* which appears on page 5of Respondents brief as follows:

1. Was there prejudice or surprise in fact of the party againstwhom the witness would testify;

2. Did the party have an opportunity to cure the defect;

3. The extent to which waiver of the rule against calling undisclosed witnesses would disrupt the orderly and efficienttrial of the case or other cases in the court; and

4. Bad faith or willfulness in failing to comply with the Court'sorder.

Respondent claims that it received no notice of the testimony of Morton Claymanand as such, was prejudiced by the taking of that testimony.

In particular, Respondent claims that had it known that Mr. Clayman was going tobe a witness for the Petitioner, it would have taken his deposition. It is interesting that it never once inquired about his availability for deposition.

In point of fact, to the extent that Petitioner may have been prejudiced by its failure to depose Mr. Clayman, the failure is due to its own inaction and not because ofany action by Petitioner.

Indeed, other than a mere allegation of "prejudice," Respondent fails to point out how it was prejudiced. Thus, even though it did not take Mr. Clayman's deposition priorto trial, Respondent was given an essentially free hand during cross-examination of Mr. Clayman. Thus, the scope of the cross-examination covered a wide range of topics and far exceeded the scope of the direct examination. In fact some questions propounded by respondent went into matters of which Mr. Clayman was unaware. He heard about thosematters for the first time when they were raised by Respondent.

Further, in the transcript of Mr. Clayman's testimony deposition, the directexamination takes 22 pages while the cross-examination takes 59 pages.

Petitioner's brief cites a myriad of cases. However, none of them are relevant to the position that it is taking. This is because all of them relate to live testimony in opencourt where a party attempted to present witnesses with out any notice. The opposing party in those situations was genuinely surprised, i.e., completely unaware of the existence of the witness.

In fact Respondent was aware of Mr. Clayman seven times prior to the taking ofhis testimony deposition.

The First time was when Respondent received the Petition to Cancel which was signed by Mr. Clayman, as President of Petitioner, who declared that all statements madetherein of his own knowledge are true and that all statements made on information and belief are believed to be true.

The Second time was when Respondent received the Amended Petition to Cancelwhich was signed by Mr. Clayman. Again, Mr. Clayman signed in his capacity as President of Petitioner, and again declared that all statements made therein of his own knowledge are true and that all statements made on information and belief are believed to be true.

In both the First and Amended Petitions to Cancel Mr. Clayman's declaration wasgiven under penalty of perjury.

The Third time was when the Respondent saw that the Petitioner was Jules Jurgensen/Rhapsody, Inc. Petitioner and Respondent have a history of litigation before to Trademark Trial and Appeal Board; Cancellation No. 92021824, April 17, 1998. In that proceeding the Board ordered that Respondent's registration No. 965,536 for URBAN be canceled as having been abandoned.

In that proceeding Mr. Clayman testified for Jules Jurgensen/Rhapsody, Inc.

The Fourth time was on October 21, 2008 during a telephone conference between Petitioner and Respondent. In addition to advising Respondent that Mr. Clayman's testimony deposition would be taken, the parties discussed their open discovery requests,settlement, and the prospect of Peter Baumberger testifying by affidavit.

The Fifth time was in response to Respondents First Set of Interrogatories; inparticular Interrogatories Nos. 3 and 4, as follows

Interrogatory No. 3:

Identify the person(s) most knowledgeable about Petitioner's Products from the first use of the Mark or any mark containing theterm "JURGENSEN" to the present.

Answer:

Morton Clayman

President

Jules Jurgensen/Rhapsody, Inc.101
West City Line Avenue Bala
Cynwyd, PA 19004

Interrogatory No. 4:

Identify each person who provided information in connection with Petitioner's Responses to Respondent's First Set of Interrogatories,and specify the Interrogatories for which each identified person provided information.

Answer:

Morton Clayman as to all of Petitioner's Responses to Respondent'sFirst Set of Interrogatories"

The Sixth time was during the first week in March when Petitioner's attorney called Respondent's attorney to schedule a date and time for Mr. Clayman's testimonydeposition. Tel. conf. on March 4, 2009 between counsel.

It was agreed that the testimony deposition would be taken on Wednesday, March18, 2009, at the offices of Petitioner. Respondent's attorney agreed that the testimony deposition could begin at 10:00 AM EDT, even though she was in Colorado.

At that time Respondent's attorney did not know if she would be authorized toappear at the testimony deposition.

Subsequently, Petitioner's attorney was advised that Respondent's attorney wouldattend by telephone. Arrangement's were made with Petitioner to be sure that Respondent's attorney would be able to hear and be heard over the telephone.

The Seventh time was when Respondent's attorney received the formal Notice ofDeposition. Rule 123(c)

Initially, it should be noted that "It is not the practice of the Board to strike depositions which have been regularly taken ..." *Entex Industries, Inc. v. Milton Bradley Co., 213 U.S.P.Q. 1116 (TTAB 1982).*

Thus, while the purpose of modern discovery procedure is to narrow the issuers,to eliminate surprise and to achieve substantial justice. The use of an undisclosed witness should seldom be barred unless bad faith in involved, *Mawby v. U.S., 999 F.2d 1252, (8th Cir. 1993).*

In this case there is no evidence nor allegation of bad faith. Thus, while Respondent knew of Mr. Clayman six times, it never once inquired about his availabilityfor deposition.

Indeed, in *Coleman v. Keebler Co., 997 F. Supp. 1102 (N.D. Ind. 1998)* the Courtstated that when the plaintiff brought the identification of a witness to the defendant's attention during a deposition the Rule 26 requirement to disclose witnesses was met.

By way of contrast to Respondents inaction, after Respondent revealed that Mr. Peter Baumberger was the person at Respondent having the most knowledge about thefacts surrounding the mark in issue in this cancellation, Petitioner inquired on *two separate occasions* as to his availability for his deposition. Once on July 15, 2008 by letter; the second on October 21, 2008 during a telephone conference with Respondent.

Respondent *never* replied to those inquiries.

A brief review of the cases relied upon by Respondent in support of its motionshow that they are not relevant in this proceeding.

Thus, in *Sears Roebuck & Co. v. Goldstone & Sudalter, 128 F.3d 10, 18 n. 7 (1st Cir. 1997),* which appears on page 3 of Respondent's brief, the "excluded witness" wasan affidavit by one Frederick Carson, a non-party. Thus, there was no opportunity to examine Mr. Carson.

Zhang v. American Gem Seafoods, Inc. 339 F.3d 1020 (9th Cir. 2003), which appears on page 3 of respondent's brief, was an employment discrimination case. The evidence excluded at trail was an alleged non-discrimination policy. The court excluded

it for four reasons; 1-It related to the policy of a separate company; 2-There was no foundation for the document; 3-It was undated and unsigned; and 4-It was not producedduring discovery.

Tronknya v. Cleveland Chiropractic Clinic, 280 F. 3d 1200 (8th Cir. 2002), whichappears on page 3 of Respondent's brief, was a fraud and misrepresentation case. The witnesses excluded at the trial *were not critical to the defense.* Further, the court said that the permitting them to testify would have been unduly prejudicial to the opposing party. The court went on to say, that the evidence excluded evidence was duplicative ofevidence already admitted at trial.

In summary, Respondent's motion should be dismissed because it had full knowledge of the high likelihood that Mr. Clayman would testify for the Petitioner. None-the-less, it chose to ignore that fact. In fact, it still has not said that it wants totake Mr. Clayman's deposition.

Respectfully submitted,

/Stuart E. Beck/

Stuart E. Beck

The Beck Law Firm
1500 Walnut Street, Suite 700
Philadelphia, Pennsylvania 19102-3504

Tel: (215) 568-6000
Fax: (215) 568-0403
Email: BeckPatent@aol.com

Attorney for Petitioner
Jules Jurgensen/Rhapsody, Inc.

Certification of Filing and of Service

I hereby certify that on April21, 2009 copies of Petitioner's Brief in Response toRespondents Motion to Strike the Testimony of Morton Clayman were filed at the Trademark Trial and Appeal Board of the United States Patent and Trademark Office electronically in accordance with Rule 126; and

Upon counsel for the Respondent by email and by first class mail to:

Andrea Anderson
Holland & Hart, LLC
One Boulder Plaza
1800 Broadway, Suite
300Boulder, CO 80302

/Stuart E. Beck/

Stuart E. Beck